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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,715	09/05/2003	Yang-Dar Yuan	600-69-CIP	8271

7590
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P.O. Box 27938
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10/03/2007

EXAMINER

GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,715

Applicant(s)

YUAN ET AL.

Examiner

Shirley V. Gembeh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-27, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 10-27, 33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed **6/22/07** presents remarks and arguments to the office action mailed **5/2/07**. Applicant's request for reconsideration of the rejection of claims in the last office action has been considered.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of Claims

Claims 1-9 and 28-32 are cancelled. Claims 10, 16, 24 and 33 are currently amended.

Claims 10-27 and 33-34 are pending.

Allowable Subject Matter over prior art

The patent 6,369,261 and 6313107 are cited to show the state of the art. Set compound teaches core structures of formulae in instant claims 16-27, however, do not teach the substituent of Y as an alkyne. The set compound is devoid of the Y group that is required of claims 16-27. Thus the prior art does not anticipate nor suggest instant claims 16-27.

Claim Objections

Claims 10-27, 33 and 34 are objected to because of the following informalities: CYP450RAI should be first defined when first used in instant claim 10. Regarding claims 10,16 and 24, the claims have non-uniform designation. For example R is CH₂OR₄ indicating a bond on the left, CH₂-O-COR₄ shows no bond. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claim 33 and dependent claim 34, R represents the residue of a compound having the structure R-COOH that has inhibitory effect on the cytochrome P450RAI (CP450RAI) enzyme. The claim fails to define what R is. The claim recites what R does as suppose to what it is. A functional language does not define what R is therefore it is vague and indefinite.

Defining R-COOH by its underlying cause renders the scope of intended uses indeterminate since, the claim language may read on any R-COOH known and yet known to have an inhibitory effect on CP450RAI. The test for determining compliance

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with 35 USC 112, paragraph two, is whether applicants have clearly defined their invention, not what may be discovered by feature research as this type of claim language clearly requires.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **10-15** are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al., US 6369,261 and Van Scott et al. US 3,932, 665 (as evident by).

The Johnson et al. reference teaches co-administration of compound of formula I with compounds of retinoic acid (vitamin A as evident by Van Scott et al. col. 2, lines 29-31), (see col. 17, lines 49-52) wherein the compound of formula I is specific inhibitor of cytochrome P450RAI (see col. 1, lines 6-10) is used (see col. 29, lines 25-43) as required by instant claims 10-15 for the treatment of psoriasis (see col. 1, lines 30-31). The substituents of the instant claims are also taught, R₁ and R₂ are hydrogens and R₃ is CH₃, (see formula col. 29, lines 25-43).

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One of ordinary skill in the art would have been motivated to use the teachings of Johnson et al. by administering the compound of claim 10 where in the compound has a cytochrome P450RAI activity with a retinoic acid for the treatment of psoriasis because as taught by Johnson et al. that administering certain inhibitors with cytochrome P450RAI results in significant increase in endogenous retinoic acid levels. The combination with retinoic acid as the reference teaches these compounds can be used with retinoic acid (see col. 10, lines 53) because retinoic acids are useful in the treatment of skin related disease.

Thus, the claimed invention was prima facie obvious to make and use at the time it was made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembel whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG
9/5/07


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER